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EXAMINER

ABDI, KAMBIZ

ART UNIT PAPER NUMBER

3621

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/710,306

Applicant(s)

SAKO, KAZUE

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
 - Claims 1, 8, and 15 are amended.
 - Claims 1-22 have been considered.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5 February 2004 has been entered.

Response to Arguments

4. Applicant's arguments filed 5 February 2004 have been fully considered but they are not persuasive for the following reasons:

In response to applicant argument regarding rejection of Claims 1, 8, and 15 under 35 U.S.C. § 103 (a);

5. The examiner believes that the argument that the applicant has put forward on regards to claims 1, 8, and 15 are not persuasive to overcome the prior art of record. The reasoning behind the argument by the applicant is that the claims recite "the issuing apparatus gives a serial number with the data to the electronic revenue stamp". Applicant is claiming that neither Lee nor Pierce references, either individually or in combination, do not disclose the above-mentioned limitation of the claims 1, 8, and 15. Examiner disagrees with the applicant and would like to bring the attention of the applicant to the fact that Lee clearly teaches the use of serial number in the revenue stamp and the utilization of such serial number in the process of the revenue stamp (See Lee figure 8, column 8, lines 31-41 and 52-59).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,285,990 to David K. Lee et al. in view of U.S. Patent 6,058,384 to Perry A. Pierce et al.

As per claims 1, 8, and 15, Lee discloses an electronic revenue stamp issuing apparatus, comprising:

- a judging means for judging whether the amount of an electronic revenue stamp to be issued is equal to or less than prepaid amount (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63);
- an issuing means for issuing said electronic revenue stamp as data on a document (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63),
- said data containing a digital signature of said electronic revenue stamp issuing apparatus on a message, said message including the document which said electronic revenue stamp is attached to, the amount of said electronic revenue stamp (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63), and
- an identifier of a receiver of said electronic revenue stamp, if said amount of said electronic revenue stamp is judged to be equal to or less than said prepaid amount (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63); and
- a balance amount reducing means for reducing said amount of said electronic revenue stamp from said prepaid amount if said electronic revenue stamp is issued (See Lee figures

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2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63, column 6, lines 1-68, and column 7, lines 1-25);.

What is not clear in Lee is the usage of the signature for further security and additional information transfer within the indicia. Lee clearly discloses the use of digital token as means of secure transaction within the metering system and record keeping for further tracking of indicia issuing and book keeping. However, Pierce clearly teaches the steps of using specifically a digital signature in order for further securing issuance and refunding of revenue stamps (See Pierce figure 2 and associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce teachings for creating revenue stamps and a more efficient, less processing time, and better security control of refunding unused revenue stamps.

As per claims 2, 9, 16, Lee and Pierce teach all the limitations of claim 1, 8, and 15, further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- a verifying means, wherein said verifying means receives a digital certificate from said receiver making an electronic revenue stamp invalid, containing a digital signature of said receiver, verifies whether said digital certificate making said electronic revenue stamp invalid is valid or not by using said identifier of said receiver; (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53), and
- an amount increasing means for increasing said prepaid amount (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53); and
- an invalid electronic revenue stamp recording means for recording said digital certificate making an electronic revenue stamp invalid (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

As per claims 3, 10, and 17, Lee and Pierce teach all the limitations of claims 1, 8, and 15 further; What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- said issuing means issues an issue number of said electronic revenue stamp issuing apparatus to said electronic revenue stamp, and
- said message include said issue number (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

As per claims 4, 11, and 18, Lee and Pierce teach all the limitations of claims 2, 9, and 15 further; What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- said verifying means verifies whether said digital certificate making electronic revenue stamp invalid is valid or not, by using said identifier of said receiver and an issue number of said electronic revenue stamp issuing apparatus (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

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As per claims 5, 12, and 19, Lee and Pierce teach all the limitations of claim 2, further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- invalid electronic revenue stamp data for storing data of electronic revenue stamps made to be invalid (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

As per claims 6, 13, and 20, Lee and Pierce teach all the limitations of claims 1, 8, and 14 further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- an issued electronic revenue stamp recording means which records issued electronic revenue stamps (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53); and
- storing means for issued electronic revenue stamp data and invalid electronic revenue stamp data (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

As per claims 7, 14, and 21 Lee and Pierce teach all the limitations of claims 2, 9, and 15 further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

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- said verifying means verifies that said digital certificate making electronic revenue stamp invalid is issued for an electronic revenue stamp issued by said electronic revenue stamp issuing apparatus and also issued by a receiver who is a valid receiver of said electronic revenue stamp, and also verifies that said digital certificate making electronic revenue stamp invalid was not used before (See Pierce abstract, figures 1 and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

As per claim 22, Lee and Pierce clearly teach all the limitations of claim 15, further;

Lee discloses,

- said program storage device storing said control program of said electronic revenue stamp issuing method is an IC card (See Lee figures 1, 2, 3 and 7 and associated text, abstract, and column 5, line 20-68, column 6, lines 1-68 and column 7, lines 1-64).

8. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

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Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K
February 18, 2004**


**JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**